

### **REMARKS**

Claims 1, 2 and 4-18 are pending in this application, with claims 20-25 withdrawn from consideration. Attached hereto is a complete listing of all claims in the application, with their current status listed parenthetically. By this Response, claims 4, 14 and 16-17 are cancelled without prejudice to later prosecution, and claim 5 is amended, and all are presented with markings indicating their current amendments.

### **In the Drawings**

In paragraph 2 of the Office Action, the Examiner objects to the drawings for not illustrating "the compressed bead having an oval configuration with a long axis parallel to an orthogonal to the longitudinal axis of the cup." In response, Applicant has cancelled dependent claims 16 and 17, without prejudice to later prosecution.

### **Rejection Under 35 U.S.C. § 112, 2nd paragraph**

In paragraph 3 of the Office Action, the Examiner rejects claims 5 and 14-17 as being indefinite. Specifically, the Examiner states that the limitation of "the opposing wall" in claim 5 lacks antecedent basis. In response, Applicant has amended claim 5.

Also the Examiner finds claim 14 is redundant in view of claim 1. In response, Applicant has cancelled claim 14.

The above-described claim amendments have been drafted in response to the indefiniteness rejection, to impart precision into the claims by more particularly pointing out the invention. The claim amendments have not been drafted to overcome any prior art.

In view of the above, Applicant respectfully requests that the Examiner reconsider and withdraw these rejections.

### 1<sup>st</sup> Rejection Under 35 U.S.C. § 103(a)

In paragraphs 4-6 of the Office Action, claims 1, 8, 9, 14 and 12-13 stand rejected as unpatentable under 35 U.S.C. § 103(a) over Japanese Patent JP401126922A ("Isotani") in view of U.S. Patent 5,036,993 ("Ramsey"), with claims 12-13 rejected over Isotani in view of Ramsey and further in view of U.S. Patent 5,368,186 ("Yeh"), Applicant respectfully traverses this rejection.

As claim 14 has been cancelled without prejudice to later prosecution, the rejection of this claim is now moot.

#### **A. The Law of Obviousness**

In order to establish a prima facie case of obviousness, three basic criteria must be met:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined), must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure." M.P.E.P. § 2142.

In the Final Office Action, the Examiner states that Isotani is silent regarding a recess for engaging the bead of the cup. Applicant agrees.

The Examiner then uses Ramsey to provide the missing teaching. However, Ramsey does not supply the features lacking in Isotani. For example, Applicant's independent claim 1, recites, in part:

". . .an annular base depending from the cap and having threads on an exterior surface of the base, the base having a recess sized to engage the bead of the cup, the base and threads being sized to threadingly engage the walls of the cup thereby deforming the walls of the cup, **and further comprising a lip opposite the base**

**and defining a portion of the recess to more fully enclose the bead of the cup."**

Neither Ramsey, nor Isotani teach a lip opposite the base that defines a portion of the recess to more fully enclose the bead of the cup.

In fact, Ramsey is virtually silent as to exactly how his closure 10 is attached to his cylindrical receptacle 14, and only states: "closure 10 is shown as being removeably attached to receptacle 14," and later: "closure 10. . . is adapted to be removeably attached to the substantially cylindrical receptacle 14" (col. 2, lines 45-50).

Isotani illustrates a flat surface that engages the bead of the cup.

In view of the above, Applicant respectfully submits that the above discussion has traversed the rejection of independent claim 1. Because claims 8-9, and 12-13 depend from claim 1, it is respectfully submitted that the rejection of claims 8-9 and 12-13 have been traversed by virtue of their dependency from claim 1. M.P.E.P. § 2143.03.

### **2nd Rejection Under 35 U.S.C. § 103(a)**

In paragraph 7 of the Office Action, claim 18 stands rejected as unpatentable under 35 U.S.C. § 103(a) over Isotani in view of Ramsey and Yeh. Applicant respectfully traverses this rejection.

Yeh teaches a safety lid for a dinking mug that includes a sealing ring 118. The sealing ring 118 "frictionally engages the outer surfaces of the side wall 100 of the lid to form a tight fit thereto" (col. 3, lines 49-51). "Alternatively, the sealing ring 118 can be adhered to the outer surface of the side wall 110 by any conventional non-toxic adhesive" (col. 3, lines 56-58). Then the "external surface 128 of the sealing ring 118 frictionally engages the inner surface of the mug 102" (col. 4, lines 26-27).

The Examiner proposes to combine Yeh's sealing ring 118 with Isotani, by stating "It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the threads on an insert of a softer material fastened to the base. . ."

However, Yeh teaches attaching the sealing ring 118 to the side wall 100 of the lid. This teaching applied to Isotani results in the sealing ring 118 placed around, and **over the threads 6** that extend from the Isotani's side wall 5. That is, **Yeh's sealing ring would cover Isotani's threads.** Moreover, there is **no need to place threads on Yeh's sealing ring 118** as it "frictionally engages the inner surface of the mug 102." Put differently, the frictional engagement eliminates the need for threads.

Finally, Isotani teaches "the lid using a material harder than that of the teacup" so that the threads can cut into the soft cup. However, Yeh teaches attachment to a rigid mug, that would not deform like the soft cup as taught in Isotani.

Therefore, Applicant submits that there is no teaching or suggestion to combine the teachings of Isotani, Ramsey and Yeh, and even if they were combined, albeit improperly, they still would not teach the elements recited in Applicant's independent claim 18.

### **3rd Rejection Under 35 U.S.C. § 103(a)**

In paragraph 8 of the Office Action, claims 1, 4-11 and 14-17 stand rejected as unpatentable under 35 U.S.C. § 103(a) over U.S. Patent 5,253,781 ("Van Melle") in view of Isotani. Applicant respectfully traverses this rejection.

As claims 4, 14 and 16-17 have been cancelled without prejudice to later prosecution, the rejection of these claims is now moot.

As discussed above, Isotani teaches a lid that has threads for cutting into a cup which is softer than the threads.

Van Melle teaches a disposable drink-through cup lid that has a cup engaging section 12 that is shaped to extend over the top rim of a disposable drink cup.

Thus, both Isotani and Van Melle teach different methods that each successfully attach their respective lids to cups.

However, the Examiner proposes to combine each of the successful methods together. "Doing so provides a **secondary engagement** which will not readily separate should one lift and carry the attached adaptor near the junction of the cup rim and adaptor recess."

Why would one skilled in the art be motivated to combine two successful attachment methods, thus providing a **secondary engagement** when both methods individually teach secure attachment?

Neither reference teaches or suggests that a **secondary engagement** method is required, and a careful reading of both references fails to reveal any hint of why a **secondary engagement** might be desired.

Applicant submits that there is absolutely no motivation to combine Isotani and Van Melle, and that the Examiner is practicing textbook hindsight reconstruction, contrary to the warnings, and requirements contained in M.P.E.P. § 2142.

**More importantly, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01**

Neither Isotani nor Van Melle contain any teaching or suggestion of why it would be desirable to provide a **secondary engagement** method, as each teach different methods that each successfully attach their respective lids to their respective cups.

The only motivation presented is the Examiner's own, generated by impermissible hindsight reconstruction. Therefore, Applicant submits that there is no teaching or suggestion to combine the teachings of Isotani and Van Melle.

In view of the above, Applicant respectfully submits that the above discussion has traversed the rejection of independent claim 1. Because claims 5-11 and 15 depend from claim 1, it is respectfully submitted that the rejection of claims 5-11 and 15 have been traversed by virtue of their dependency from claim 1. M.P.E.P. § 2143.03.

#### **4th Rejection Under 35 U.S.C. § 103(a)**

In paragraph 9 of the Office Action, claims 1 and 2 stand rejected as unpatentable under 35 U.S.C. § 103(a) over U.S. Patent 3,120,912 ("Mount") in view of Isotani. Applicant respectfully traverses this rejection.

Mount teaches "a closure lid which is adapted to be readily cleaned or sterilized for re-use" (col. 2, lines 29-31). "[T]he lid 3 is in the nature of a permanent lid intended for repeated use and in this embodiment is made from stainless steel or other suitable stiff material which may be subjected to sterilization by heat as by treating in an autoclave at approximately 350° F" (col. 2, lines 56-60). Mount's lid has a "downwardly extending peripheral flange portion 23 adapted to snugly fit within the lip wall 24 of the container 20 and provided at its lower edge with a bead 25 for interfitting engagement within an internal recess 26 of the container lip" (col. 3, lines 64-69). Thus Mount teaches a stainless steel lid having a bead for fitting within a container's recess.

Isotani teaches a disposable lid likely made of plastic that has threads for cutting into the walls of a container.

The Examiner provides the motivation to combine as follows: "It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the substitute the [*sic*] external bead with threads since the examiner takes Official Notice of the equivalence of threads and annular beads for their use in the closure art and the selection of any of these known equivalents to secure a closure to a cup would be within the level of ordinary skill in the art."

Applicant respectfully traverses the Examiner's assertion and requests a reference in support of her position. M.P.E.P. § 2144.03.

Moreover, even if these two references were combined, albeit improperly, they would still not teach all of Applicant's recited claim elements, specifically, "a lip opposite the base and defining a portion of the recess to more fully enclose the bead of the cup."

In view of the above, Applicant respectfully submits that the above discussion has traversed the rejection of independent claim 1. Because claim 2 depends from claim 1, it is respectfully submitted that the rejection of claim 2 has been traversed by virtue of its dependency from claim 1. M.P.E.P. § 2143.03.


**Conclusion**

Applicant believes that this Response has addressed all items in the Office Action and now places the application in condition for allowance. Accordingly, favorable reconsideration and allowance of claims 1-2 and 4-18 at an early date is solicited. No fee is believed due with this response. Should any issues remain unresolved, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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Date



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